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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/20/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

805316

Applicant(s)

GREEN

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 4/11/02

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1 - 13 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 - 13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants specification fails to teach that the material is "raw", and this thus introduces new matter into the claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 teaches the term "raw" without defining the term therein or in the specification, the scope of the claim is thus not certain. Dependent claims fall herewith.

Claims 2-10 and 12 teach the terms "selected from the group consisting essentially of", which renders the claims indefinite, since none of the listed materials have to be present in the pellet, and others not listed may be part of the pellet. The proper term for such Markusk grouping is "selected from the group consisting of" (see MPEP 2173.05(h)).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bloys (5065820).

Bloys teaches a lost circulation additive which comprises compressed sponge particles (column 3, lines 14-25).

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7. Claims 1, 2, 7-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (4836940).

Alexander teaches a lost circulation additive which comprises pellets of bentonite and a polymer (see claim 1).

8. Claims 1, 2, 7, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cremeans (4217965).

Cremeans teaches a lost circulation additive which comprises ground cottonseed hulls (see claim 1 and column 3, line 67 - column 4, line 2).

9. Claims 1, 2, 5, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagener (4428844).

Wagener teaches a lost circulation additive which comprises pellets of paper (see column 4, line 30 - column 5, line 21).

10. Claims 1, 2, 7, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (4462470).

Alexander teaches a lost circulation additive which comprises pellets of clay (column 3, lines 31-45).

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11. Claims 1, 2, 7-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Armentrout (2836555).

Armentrout teaches a lost circulation additive which comprises compressed pellets of bentonite clay (see claim 1).

12. Claims 1, 2, 7, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Armentrout (2642268).

Armentrout teaches a lost circulation additive which comprises compressed pellets of materials such as bentonite (see claim 1 and column 3, line 50 - column 4, line 35).

13. Applicants arguments have been considered but are not deemed totally persuasive. Cowan (5076944) teaches the grinding of the pellets, thus a final product of a pellet is not achieved, and is thus distinguished from the present invention. The other rejections are maintained.

Applicants have argued that the term "dry" has been added to claim 1. However, applicants amended claims do not contain the term "dry" therein. Thus applicants arguments that such is a distinguishing feature with respect to Bloys and Wagener is moot, since such term does not appear in the claims. Furthermore, the use of the term "dry" if introduced, would be new matter, since such is not taught by applicants specification.

Applicant has argued the use of the term "consisting essentially of" in a Markush group. Applicant has rightly noted that consisting essentially of can be used when citing components

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which are positively cited as being a part of the claim. Such is not proper in the alternative language used in a Markush group, since such would imply that none of the listed materials have to be present in the pellet, and others not listed may be part of the pellet. The proper term for such Markusk grouping is "selected from the group consisting of" (see MPEP 2173.05(h)).

Applicant has also argued such as in the case of Cremeans, Wagener and Armentrout that the claims teach that the material is not "chemically treated". This term does not appear in any of the claims. The insertion of "raw" does not distinguish, since the claim uses the language "comprising" in describing the ingredients of the pellet. Thus the addition of other materials such as in Cremeans, Wagener and Armentrout is not distinguished from applicants claims. Furthermore, the extrusion of a material through a die to form a pellet must involve the densifying of the material. Contrary to applicants arguments, finely divided material, not lumps are used to form the pellets or Armentrout '268 (see column 3, lines 51-56). The use of the term ground, does not distinguish over other means of finely dividing materials, since the claims are product by process claims, in which only the product is examined (In re Thorpe 227 USPQ 964). Furthermore, a specific particle size of the materials is not taught in applicants claims to distinguish over the prior art. The rejections are thus maintained

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2493  
June 18, 2002

  
PHILIP C. TUCKER  
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